

REMARKS

Claims 1-4, 9-14 and 19-21 have been examined. Claims 5-8, 15-18 and 22-35 have been canceled. With this Amendment, Applicants add claims 36-51. Claims 1-4, 9-14, 19-21 and 36-51 are all the claims pending in the application.

1. Formalities:

Applicants thank the Examiner for acknowledging the Election of Group I (claims 1-4, 11-14 and 21) and for accepting Applicants' request to include claims 9, 10, 19 and 20 into Group I.

Applicants confirm the Examiner's cancellation of non-elected claims 5-8, 15-18 and 22-35.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for confirming that the certified copy of the priority document has been received.

2. Claim Rejections under 35 U.S.C. § 112:

The Examiner has rejected claims 3, 4, 13, and 14 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. Specifically, the Examiner alleges that the phrase "the interface unit" recited in line 9 of claims 3 and 13 lacks antecedent basis.

Applicants submit that the modifications to claims 3 and 13 obviate the rejections.

3. Claim Rejections under 35 U.S.C. § 102:

The Examiner has rejected claims 1, 2, 9, 11, 12, 19 and 21 under 35 U.S.C. § 102(e) as being anticipated by Endo et al. (US 6,335,796) ["Endo"]. Applicants traverse the rejection.

Claim 1 recites an interfacing method steps for "a plurality of network printers...[that] are connected by an interface unit to an image information network" wherein the method is comprised "in the interface unit." The Examiner alleges that Endo discloses this feature because Figures 1, 2, 14 and 15 disclose interfaces 13 and 66 connected to LANs 5 and 55, respectively.

Applicants submit that one skilled in the art would readily recognize that the interfacing method steps as recited in claim 1 require that the interface unit itself perform the recited steps and be connected to the printers. Figures 1, 2, 14 and 15 of Endo clearly show that interfaces 13 and 66 connect the LAN to the operator panel 3 and Radiation Device 53, not the printers. Further, any disclosure in Endo that may relate to the recited steps is clearly being performed by a user via the operating panel 3 and Radiation Device 53, not the interfaces 13 and 66. Therefore, Endo does not disclose or remotely suggest the claimed combination.

Because claim 2 depends on claim 1, Applicants submit that claim 2 is patentable at least by virtue of its dependency. Claim 2 is further distinguishable from Endo by virtue of the features set forth therein.

For example, claim 2 recites that "in cases where there is no network printer, which corresponds to the kind of film coinciding with said output request, a network printer, which corresponds to the kind of film closest to the kind of film coinciding with said output request, is selected." The Examiner alleges that the printing of an image by the available printer for the displayed film size discloses this feature (col. 6, lines 7-13).

Applicants submit that Endo discloses that only film sizes that are already available in the network printers are displayed by the operator panel (col. 5, lines 56-58). Because an operator

cannot request a film kind that is not already available, Endo does not disclose or even remotely suggest selecting a different film kind as set forth in the claimed combination.

Because claim 9 is dependent on independent claims 1 and 3, Applicants submit that claim 9 is patentable at least by virtue of its dependency to claim 1 for the reasons stated above and claim 3 for the reasons stated below.

Because claim 11 recites features similar to claim 1, Applicants submit that it is patentable for at least the reasons given above.

Also, Claim 11 recites “an interface unit comprising ...a film kind recognizing means ...and...a printer selecting means” which are specific elements where user operation is not part of the elemental feature. As stated above, any disclosure in Endo that may relate to the recited steps requires a user to perform the steps. Applicants submit that method steps such as those performed by an operator, do not establish the presence of elemental steps of claims for an apparatus. See *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993).

Because claim 12 recites features similar to claim 2, Applicants submit that it is patentable for at least the reasons given above.

Because claims 19 and 21 are dependent on independent claims 11 and 13, Applicants submit that claims 19 and 21 are patentable at least by virtue of their dependency on claim 11 for the reasons stated above and claim 13 for the reasons stated below.

4. Claim Rejections under 35 U.S.C. § 103:

The Examiner has rejected claims 3, 4, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Mori (US 6,070,000). Applicants traverse the rejection.

The Examiner concedes that that Endo does not disclose network printers "wherein at least one network printer among a plurality of network printers...is connected by each of at least two interface units to an image information network...sending information...to the other interface unit." To cure this deficiency, the Examiner applies Mori.

Applicants submit that it would not have been obvious for one skilled in the art to combine the teaching of Endo and Mori because the problem solved by Mori does not exist in Endo.

Mori discloses the use of a plurality of printers connected in series to print data if the first printer is unavailable (Abstract). The object of Mori is to prevent delays in work operations because print jobs may be sent to a printing device that is unavailable (Col. 1, lines 14-24).

The printers in Endo are network connected (Figure 1) and, as stated above, the operator panel in Endo only displays the available film sizes (i.e. available network printers) for user selection. Therefore, it is impossible to print to an unavailable printer in Endo. Therefore, one skilled in the art would not be motivated to combine these references because the teachings of Mori are not needed in Endo. This demonstrates that the Examiner's proffered reasons for combining the references are not supportable. In particular, the Examiner alleges that the additional interface unit permits the user to have optional printers. However, the operation of Endo already permits this viewing of printers without the further interface unit purportedly provided by Mori.

The lack of a viable rational for combining the references demonstrates that improper hindsight rather than teachings in the art, provided the motivation to combine.

Because claims 3 and 13 recite features similar to claim 1 and Mori does not cure the deficient teachings of Endo with respect to these features, Applicants submit that claims 3 and 13 are patentable for at least the reasons given in claim 1.

Because claims 4 and 14 are dependent on claims 3 and 13, respectively, Applicants submit that claims 4 and 14 are patentable at least by virtue of their dependency. In addition, because claims 4 and 14 recite features similar to claim 2 and Mori does not cure the deficient teachings of Endo with respect to these features, Applicants submit that claims 4 and 14 are patentable for at least the reasons given in claim 2.

The Examiner has rejected claims 10 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of McCormack et al. (US 6,295,527) [“McCormack”]. Applicants traverse the rejection.

The Examiner concedes that Endo does not teach the Simple Network Management Protocol or that the displaying software is a Hyper Text Transfer Protocol, but applies McCormack to allegedly cure the deficiency.

Because claim 10 depends on independent claims 1 and 3 and claim 20 depends on independent claims 11 and 13 and McCormack does not cure the deficient teachings of Endo and Mori with respect to the features found in the independent claims, Applicants submit that claims 10 and 20 are patentable at least by virtue of their dependency to their respective base claims.

5. New Claims:

With this amendment, Applicants add claims 36-51. Applicants submit that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

6. Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Pursuant to 37 C.F.R. § 1.136, Applicants are filing a petition (with fee) for one month of extension time herewith, making this response due on or before April 5, 2004 (April 3, being a Saturday). The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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